

### **Remarks**

Claims 1-37 are pending. Reconsideration is respectfully requested.

### **The Restriction Requirement**

In response to the Office Action dated April 3, 2007 requiring restriction election, Applicants provisionally elect with traverse Group I (claims 1-22, 24-30, 32, and 34-36). Reconsideration and withdrawal of said restriction requirement are respectfully requested. As shown in more detail herein, the restriction requirement is without legal basis.

### **The Alleged Groups**

The Action alleges that the following Groups are related as subcombinations (MPEP § 806.05(d)) and are distinct from each other:

- I. Claims 5-22 and 28, with claims 1-4 alleged to be generic.
- II. Claims 23-27 and 29-30, with claims 1-4 alleged to be generic.
- III. Claims 31-37, with claim 1 alleged to be generic.

### **The Restriction Requirement is not legally proper because the alleged claim grouping is *prima facie* incorrect**

Also, the Office alleges the claims 24, 26-27, 29-30, and 32 to be in an alleged Group II ("Group II"). However, these claims (24, 26-27, 29-30, and 32) depend from claim 22, which is in the alleged Group I ("Group I"). Thus, for the Office to allege that these claims (which depend on the Group I claims, and thus include the features and relationships thereof) are distinct from the Group I claims is nonsensical. The claim dependency itself is *prima facie* evidence against the allegation of distinctness between the Group I claims and the claims 24, 26-27, 29-30, and 32 of Group II.

Likewise, claims 34-36 depend from claim 22 of Group I. Yet the Office insists that these claims belong in an alleged Group III ("Group III"). Again, for the same reason of claim dependency, the Office's allegation that these claims 34-36 are distinct from the Group I claims is nonsensical.

Also, the Action (at numbered paragraph 4) admits that claims 25-26 are generic to each of the alleged Groups I, II, and III.

Therefore, the alleged claim grouping is unclear. *As best understood*, the Action alleges that the following Groups are related as subcombinations and are distinct from each other:

- I. Claims 1-22, 24-30, 32, and 34-36, with claims 1-4 generic.
- II. Claims 1-4, 23 and 25-26, with claims 1-4 generic.
- III. Claims 1, 25-26, 31, 33 and 37, with claim 1 generic.

**The Restriction Requirement is not legally proper because the criteria applied for restriction requirement is legally improper**

The Action alleges that Groups are related as subcombinations. MPEP § 806.05(d) sets forth the claim situation which must occur before an allegation of distinct subcombinations can even be considered by the Office. That is, it sets forth the claim criteria needed to allege distinct subcombinations. The initial claim criteria requires that claims be directed to separately claimed plural *subcombinations* and a separately claimed *combination*. That is, at least three groupings of claims are to be present which must include at least a combination grouping and two subcombination groupings. Furthermore, the combination must include the particulars of the subcombinations. The claim arrangement must be set forth as A/B/C (the combination grouping), B (the first subcombination grouping), and C (the second subcombination grouping).

Which single combination claim includes all of the alleged subcombinations I, II, III?

The Office conveniently has not explained which claims are directed to the needed combination grouping and subcombination groupings. Nor can it. Regardless, the MPEP makes clear that the claims 1-37 do not meet the required criteria for subcombination restriction.

Claim 1 is the only independent claim pending. At best, the Action mere alleges that the claims are related as  $AB_{sp}/B_{sp}$ . Under such claim situation the criteria to be followed is at MPEP § 806.05(c)(I), which states that "a requirement for restriction must not be made".

**The Restriction Requirement is not legally proper because there is no serious burden**

MPEP § 803 sets forth criteria for a proper election requirement. One of the criteria is that there must be a serious burden on the Examiner in order for election to be required. Conversely, if the search and examination of an entire application can be made without serious burden on an Examiner, then it must be examined on the merits. Applicants respectfully submit that the requirement is not legally proper because the criteria for serious burden has not been met.

**The Restriction Requirement is improperly based on incorrect Group definitions**

The Action indicates that Group I is directed to a blocking gate working in concert with an interlocking follower. However, the Action is silent as to which claim in Group I recites an "interlocking follower". Nor does any claim. It appears that the Office confuses the recited invention with a different application. At best, a "follower" first appears in claim 6 which depends on claim 5. Thus, the Office's reliance on a feature (for the Group I definition) that doesn't even appear in all of the claims in the alleged Group I is legally improper.

The Action indicates that Group II is directed to an envelope transporting container. However, the Action is silent as to which claim in Group II recites an "envelope transporting

container". At best, claim 23 recites an "envelope *holding* container", not an "envelope *transporting* container". Again, the record indicates that the Office confuses the recited invention with a different application. Regardless, the Office does not explain, nor can it, how the "envelope holding container" of claim 23 (Group II) differs from the "envelope holding container" of claim 22 (Group I). Compare claims 22 and 23.

The Action indicates that Group III is directed to controlling of a dispensing gate. However, the Action is silent as to which claim in Group I recites a "dispensing gate". Again, the Office confuses the recited invention with a different application. Regardless, claim 1 recites a gate. All of the other claims (and all alleged Groups) depend from claim 1. Thus, the relied upon gate feature cannot be used to show distinctness between the alleged Groups.

Applicants have shown that the relied upon Group definitions are incorrect. On this basis alone the restriction requirement is legally improper and should be withdrawn.

As best understood, the restriction requirement is meant for an application other than Applicants' application. Thus, Applicants respectfully submit that the restriction requirement should be withdrawn from their application and applied to the other (correct) application.

**The Office has not shown the alleged Groups to be distinct**

The burden is on the Examiner to provide valid examples. If Applicants prove or provide an argument that the Examiner's suggested other use cannot be accomplished or is unreasonable, then the burden is on the Examiner to document a viable alternative use or withdraw the requirement. MPEP § 806.05 (d). Applicants respectfully submit that the Office has not met its required burden. Each separate utility alleged by the Office is unreasonable, as discussed herein.

The Action also has not provided the required showing of distinct subcombinations. The Action is absent a showing that the alleged subcombinations do not overlap in scope, are not obvious variants, and are separately usable. For example, claim 1 is the only independent claim. The Office has not explained, nor can it, how the dependent claims would not overlap in scope. Additionally, the Office has not shown that each alleged subcombination I, II, and III is separately usable (i.e., can be used without its generic claim). The Office misinterprets and misapplies the meaning of "separately usable." Nor has the Office shown two-way distinctness.

#### Group I

The alleged separate utility of "a security gate in preventing unauthorized access to the dispensate through a dispensing outlet" for Group I is unreasonable and legally improper. Again, claim 1 is the only independent claim. Claim 1 recites a "gate". The Office has not explained, nor can it, how the gate of only Group I could be used as "a security gate" when all of the other alleged Groups II and III also have the same gate of claim 1.

Therefore, even if it were somehow possible for the Office to show that "a security gate" is a reasonable utility for Group I, the Office still couldn't show that the alleged Group I has separate utility from the alleged Groups II and III. In other words, if Group I can be used with a security gate as alleged, then so can Groups II and III. The Office has not shown that "a security gate" is a utility uniquely attributed to Group I. Thus, the attempted restriction between Groups I/II and I/III is legally improper.

The Office has not shown the alleged subcombinations I/II and I/III to be separately usable. Thus, the Office has not shown the alleged subcombinations to be distinct. As the Office has not met its legal burden, the restriction requirement is improper and should be withdrawn.

## Group II

The alleged separate utility of moving or conveying documents to an alternate dispensing port for Group II is unreasonable and legally improper. The record lacks evidence of such utility.

Furthermore, the Office has not shown that moving or conveying documents to an alternate dispensing port is a utility uniquely attributed to Group II. What specific language in Group I (or Group III) prevents its use with moving or conveying documents to an alternate dispensing port? There isn't any, especially when Groups I and III (like Group II) depend on the same independent claim 1. Thus, restriction between Groups II /I and II/III is legally improper.

## Group III

The alleged separate utility of remotely controlling dispensing for Group III is unreasonable and legally improper. The record lacks evidence of such utility.

Furthermore, the Office has not shown that "remotely controlling dispensing" is a utility uniquely attributed to Group III. Claim 30 of Group I also has a controller/drive. Therefore, even if it were somehow possible for the Office to show that "remotely controlling dispensing" is a reasonable utility for Group III, the Office still couldn't show that the alleged Group III has separate utility from Group I. If Group III has the utility of "remotely controlling dispensing" as alleged, then what specific language in Group I would prevent its use with "remotely controlling dispensing" (the alleged utility uniquely attributed to Group III)? There isn't any such specific language in Group I. Thus, restriction between Groups III and I is legally improper. Likewise with Groups III/II.

## Conclusion

As previously discussed, the Office has not provided a showing that the alleged subcombinations are separately usable. It follows that the Office has not shown the alleged subcombinations to be distinct. Furthermore, Applicants have proven that the Office's attempted restrictions between Groups I/II, Groups I/III , and Groups II/III are *prima facie* legally improper due to similar features being recited in the related Groups (i.e., the alleged subcombinations overlap in scope). Applicants have shown that the Office has not met its legally required burden for imposing a restriction. Thus, the improper restriction requirement should be withdrawn.

Applicants respectfully submit that the rules and Office examining procedures were designed to specifically prevent the type of restriction requirement being improperly imposed by the Examiner. Else every dependent claim would be restrictable from each other in every application.

## Rejoinder

The Examiner's acknowledgment (at numbered paragraph number 6) that "Several claims are subject to rejoinder contingent upon their dependence from an allowable base claim" is appreciated. Also, once a generic claim is allowable, all claims being either dependent thereon or including the allowable subject matter will likewise be allowable.

## **The Restriction Requirement Is Without Legal Basis**

Applicants also respectfully wish to point out that the Action fails to state a legally sufficient basis for imposing a restriction requirement. The Action indicates that the restriction requirement is solely based on a showing of the alleged inventions being "distinct." The statutory authority for the Patent Office to impose a restriction requirement is found in 35 U.S.C.

§ 121. The statute expressly states that before the Patent Office may require restriction, the inventions must be both “independent” and “distinct.” The regulations that have been promulgated pursuant to this statute, 37 C.F.R. § 1.141 and 37 C.F.R. § 1.142, both expressly state that before a restriction requirement may be imposed the inventions claimed must be both independent and distinct.

In the Action, there are only unsupported assertions that the sets of claims are “distinct.” There are no assertions that the sets of claims are “independent”, as is required. This standard does not comply with the statutory requirements. Therefore, the standard used in the Action for seeking to impose a restriction requirement is legally incorrect due to noncompliance with the clear wording of both the statute and the regulations promulgated thereunder. The application of such an incorrect legal standard is arbitrary, capricious, and contrary to law in violation of the Administrative Procedures Act.

Furthermore the Patent Office has acknowledged that before claimed inventions can be considered to be “independent” the inventions must be unconnected in design, operation, or effect. MPEP § 802.01. The Office has not shown that the claims directed to Applicants' invention are unrelated in design, operation, and effect. Thus, the statutory requirements have not been met and no restriction requirement may be imposed.

### **Conclusion**

For all the foregoing reasons it is respectfully submitted that there is no valid basis for the restriction requirement. Applicants reserve the right to present even more reasons why the restriction requirement is legally improper. Applicants respectfully request that the requirement be withdrawn.



Respectfully submitted,



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